

## **REMARKS**

Claims 1-9, 12-20, 22-29, and 31-33, and 36-37 are pending in this Application. By this Amendment, claim 3 has been amended, new claims 36-37 have been added, and claims 34-35 have been canceled without prejudice to or disclaimer of the subject matter contained therein. No new matter is added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

### **I. Summary of Telephone Interview**

The Applicant appreciates the courtesies extended to the Applicant's representative during the October 25, 2007, telephone interview with Examiner Gerezgiher, and thanks Examiner Gerezgiher for sending an Advisory Action via a facsimile letter dated October 26, 2007.

### **II. Formal Matters**

#### **A. Rejection under 35 U.S.C. §112, First Paragraph**

The Office Action rejects claims 1-9, 12-20, 22-29, and 31-33 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Applicant respectfully traverses this rejection as follows.

The Office Action, on pages 3-4 and 12, asserts that the feature "wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller," as recited in claim 1 and similarly recited in claims 16 and 24, is not enabled by the specification. Further, the Office Action asserts that the language in the Specification at page 24, lines 14-17, which the Applicant submitted as enabling support and which recites, "it is preferred that the public viewer 912 be limited to receiving one or two books at a time from the controller 908," is a plain statement that could not be enabling support of the claimed limitation. Further still, the Office

Action, on page 12, asserts that “there is no functional limitation that prevents the viewer from downloading e-books based on a defined number of books.”

The Applicant respectfully disagrees and asserts that the language “it is preferred that the public viewer 912 be limited to receiving one or two books at a time from the controller 908,” as recited at page 24, lines 14-17, of the Specification, is indeed enabling. In particular, the Applicant submits that the Specification, including the aforementioned language, is written in such terms as to enable any person skilled in the art to which it pertains, to make and use the claimed invention. The Applicant submits that it would not require undue experimentation for one of ordinary skill in the software art to limit the downloading of electronic books to a chosen number of books, using the hardware and software shown and described in at least Fig. 15 and pages 23-25 of the Specification.

Thus, the Applicant submits that claims 1-9, 11-20, and 22-29, and 31-33 comply with the written description requirement. Accordingly, the Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §112, first paragraph.

### **III. Claims Define Patentable Subject Matter**

The Office Action rejects claims 1-9, 12-20, 22-29 under 35 U.S.C. §103(a) as being unpatentable over Warnock (U.S. Patent No. 5,634,064) in view of Tsuchiya (U.S. Patent No. 5,239,665). To the extent these rejections remain applicable to the claims, the Applicant respectfully traverses these rejections as follows.

#### **A. Independent Claim 13**

Regarding claim 13, the Applicant asserts that Warnock and Tsuchiya, either individually or in combination, fail to disclose or suggest a system for accessing electronic books including at least the combination of a catalog printer connected to a file server for storing books, wherein the catalog printer is capable of printing

information about the electronic books stored on the file server, wherein the electronic books have encoded text, and wherein the catalog printer cannot access the encoded text, as recited in claim 13.

Warnock merely discloses an electronic document viewer including a digital computer system and an electronic document stored in the memory of the computer system, wherein a printer can be used for displaying a document. Warnock, however, does not disclose or suggest at least a catalog printer that prints information about electronic books and cannot access the encoded text of electronic books, as recited in claim 13.

Tsuchiya, in combination with Warnock, as cited by the Examiner, also fails to disclose at least the combination of features recited in claim 13, and therefore, fails to make up for the deficiencies of Warnock. Thus, for at least this reason, the Applicant submits that claim 13 is allowable over the cited references.

**B. Dependent Claims 36-37**

Regarding new claims 36-37, which depend from amended claim 3, the Applicant submits that Warnock and Tsuchiya, either individually or in combination, fail to disclose or suggest a system for accessing electronic books including at least the combination of a viewer having a memory that stores a selected electronic book in encoded form, wherein the viewer includes a secure microprocessor for decoding the encoded electronic book only at the time of display, as recited in new claim 36; and wherein the secure microprocessor decodes the encoded electronic book data page-by-page, as recited in new claim 37.

Thus, for at least this reason, the Applicant submits that claims 36-37 are allowable over the cited references.

**C. Independent Claims 1, 16, and 24**

Regarding claims 1, 16, and 24, the Applicant asserts that Tsuchiya and Warnock, either individually or in combination, fail to disclose or suggest a system for accessing electronic books including at least the combination of a file server that stores electronic books, a controller connected to the file server for controlling access to electronic books on the file server, and a viewer adapted for connection to the controller, which viewer stores and displays electronic books, wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller, as recited in claim 1 and similarly recited in claims 16 and 24.

The Office Action, on page 13, alleges that the electronic book device of Tsuchiya has a limited capability and capacity of storage, and that this implies that the electronic book device of Tsuchiya downloads or receives a limited number of electronic books from a server.

The Applicant respectfully disagrees and asserts that, even if the Examiner's assertions were true (which the Applicant does not admit), "a limited capability and capacity" of the electronic book device of Tsuchiya does not limit such a device to receive a determined number of electronic books at a time from the controller, as recited in claims 1, 16 and 24.

Tsuchiya, as cited, merely discloses an electronic book and an automatic vending machine. Tsuchiya, however, fails to disclose or suggest at least the combination of features recited in claims 1, 16, and 24.

Warnock, in combination with Tsuchiya, as cited by the Examiner, also fails to disclose at least the combination of features recited in claims 1, 16, and 24, and therefore, fails to cure the deficiency in Tsuchiya.

Thus, for at least the above reasons, the Applicant submits that claims 1, 16, and 24 are allowable over the cited references. As claims 1, 16, and 24 are

allowable, the Applicant submits that claims 2-9, 12, 14-15, 17-20, 22-23, 25, 27-29, 31-33, and 36, which depend from allowable claims 1, 16, and 24, respectively, are likewise allowable for at least the above noted reasons and for the additional subject matter recited therein.

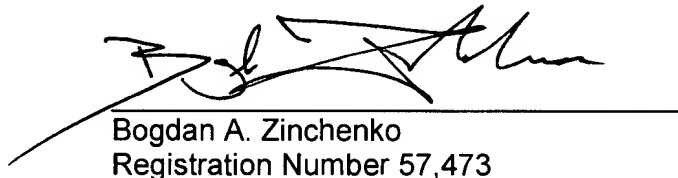
**IV. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-9, 12-20, 22-29, 31-33, and 36 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number set forth below.

In the event this paper is not considered to be timely filed, the Applicant hereby petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt. No. 026880-00021.

Respectfully submitted,



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